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EXAMINER				
TZENG, MICHAEL Y				
ART UNIT		PAPER NUMBER		
2625				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/588,059

**Applicant(s)**

KURATA, KENICHI

**Examiner**

Michael Tzeng

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's preliminary amendment filed on 8/1/2006 has been entered. Claim 3 has been amended. No claims have been canceled. No claims have been added. Claims 1-18 are still pending in this application, with claims 1, 5, 7, 9, 10, and 16-18 being independent.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9 and 17 sets forth a "recording medium...executed in a terminal apparatus." However, the specification as originally filed does not explicitly define the recording medium in any shape or form.

The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during

patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable storage media (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is absent an explicit definition or is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-10 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (US Patent No. US 6,369,909 B1) and Lee (US Patent Application Publication No. US 2004/0141487 A1).

Regarding **claim 1**, Shima discloses a printing process control method provided in a terminal apparatus comprising a storing means which stores image data to be printed (Col. 8 lines 1-3 disclose the storage device),

wherein, said control means obtains from the printing apparatus, information regarding an attribute of the apparatus, said control means determines whether or not said printing apparatus supports a predetermined expanded specification, based on the information regarding the attribute thus obtained (Fig. 3 disclose determining an attribute of the printer as to whether the printer can interpret a received language),

when it is determined that the printing apparatus supports said predetermined expanded specification, data obtained by processing said image data to be printed according to said predetermined expanded specification is transmitted to said printing apparatus in a predetermined file format, and when it is determined that said printing apparatus does not support said predetermined expanded specification, data for identifying said image data to be printed is transmitted to said printing apparatus in a predetermined file format (Fig. 3 disclose the printing of the print data whether or not the printer supports the received language).

However, Shima does not disclose the wireless communication between the printing apparatus and the terminal apparatus.

Lee in a method of networking printer, discloses a wireless printer in communication with a terminal device (Abstract discloses the wireless devices; Fig. 1 discloses the wireless devices in a wireless network).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Shima to include the teachings of Lee for increasing simplicity and ease of use (as taught by Lee in the Background).

Regarding claim 4, depending on claim 1, Shima discloses wherein, said control means obtains information from said printing apparatus, information regarding a function of the printing apparatus, in addition to the information regarding the attribute of said printing apparatus, and displays a print settings accepting screen having been modified based on said information thus obtained regarding the function of the printing apparatus, prior to transmitting data in said predetermined file format to said printing apparatus (Figs. 17A-B disclose the print settings screen regarding the formats).

**Claim 5** is rejected under the same grounds as claim 1.

**Claim 6**, depending on claim 5, is rejected under the same grounds as claim 4.

**Claim 7** is rejected under the same grounds as claim 1.

**Claim 8**, depending on claim 7, is rejected under the same grounds as claim 4.

**Claim 9** is rejected under the same grounds as claim 1.

Regarding claim 10, Shima discloses a terminal apparatus, comprising, a list displaying means which displays a list of printing apparatuses available for communication, and accepts a selection of the printing apparatus which is used for printing (Fig. 26 discloses the list of printers available for communication),

a search requesting means which issues a search request for devices (Fig. 26 discloses the inquiry of the printers),

a printing apparatus extraction means which extracts a printing apparatus from the devices responding to said search request (Fig. 28 discloses selecting a printing apparatus),

a printing apparatus information requesting means which requests information regarding said printing apparatus from said printing apparatus thus extracted (Fig. 26 discloses extracting information),

a determining means which determines whether or not information in response to said printing apparatus information request satisfies a predetermined condition (Fig. 26 discloses whether or not the device can render a type of file format),

and a printing apparatus registering means in which when it is determined said condition is satisfied, information for identifying said printing apparatus is registered in a higher order of the list, and when it is determined said condition is not satisfied, the information for identifying the printing apparatus is registered in a lower order of the list (Fig. 21 discloses the elimination of printers to a lower order in which the condition is not satisfied).

However, Shima does not disclose the wireless communication between the printing apparatus and the terminal apparatus.

Lee in a method of networking printer, discloses a wireless printer in communication with a terminal device (Abstract discloses the wireless devices; Fig. 1 discloses the wireless devices in a wireless network).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Shima to include the teachings of Lee for increasing simplicity and ease of use (as taught by Lee in the Background).

**Claims 16, 17 and 18** are rejected under the same grounds as claim 10.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shima and Lee in view of Gimenez (US Patent Application Publication No. US 2003/0182475 A1).

Regarding claim 2, depending on claim 1, Shima does not disclose the MIME specification.

Gimenez disclose in a printer management system, that printers can support the MIME specification (Paragraph 222 discloses the printer processing documents that have been encoded with the MIME standard).

Therefore, it would have been obvious to one having ordinary skill in the art to modify the invention of Shima and Lee to use MIME as a specification for the printer. As taught by Gimenez in Paragraph 222, the MIME specification is standard and well-known for web devices, and using this would be easy and convenient for the user.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shima and Lee in view of Miyazawa et al. (US Patent Application Publication No. US 2005/0036172 A1, hereinafter "Miyazawa").



Regarding claim 3, depending on claim 1, Shima discloses HTML but does not disclose XHTML.

Miyazawa teaches that in a printing method, XHTML file formats can be sent to the printer (Paragraph 23 discloses the use of XHTML files for printing).

Therefore, it would have been obvious to one having ordinary skill in the art to modify the invention of Shima and Lee to include the teachings of Miyazawa since XHTML was a standard and would have allowed ease and convenience to the user for receiving documents in well-known formats.

9. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima and Lee in view of Suzuki et al. (US Patent No. US 6,745,256 B2, hereinafter "Suzuki").

Regarding claim 11, depending on claim 10, Shima does not disclose wherein said determining means determines as said predetermined condition, whether or not a manufacturer of said printing apparatus included in the response information to said printing apparatus information request is a predetermined manufacturer.

Suzuki teaches in a printer method that determines the properties of the printer that the manufacturer can be determined (Fig. 46 discloses the manufacturer).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Shima and Lee to include the teachings of Suzuki. The motivation for this is for compatibility purposes to ensure the printer functions.

Regarding claim 15, depending on claim 10, Shima does not disclose the information for identifying a printing apparatus which said printing apparatus registering means registers in said list is a manufacturer name of said printing apparatus and a model name of said printing apparatus, which are included in the response information to said printing apparatus information request.

Suzuki teaches in a printer method that determines the properties of the printer that the manufacturer and model can be determined (Fig. 46 discloses the manufacturer and the model).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Shima and Lee to include the teachings of Suzuki. The motivation for this is for compatibility purposes to ensure the printer functions.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shima and Lee and Suzuki in view of Shiohara (US Patent No. US 6,804,019 B2).

Regarding claim 12, depending on claim 11, Shima does not disclose wherein said predetermined manufacturer is identical to a developer of a program to control printing process in the terminal apparatus.

Shiohara discloses in a printing method, that the manufacturer of the printer and the identical developer of the printer drivers can be determined (col 9 lines 44-50 disclose the manufacturer being the same for the printer and the printer drivers).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Shima and Lee and Suzuki to include the teachings of Shiohara to ensure compatibility.

11. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima and Lee and Suzuki in view of Shima et al. (US Patent Application Publication No. US 2004/0125163 A1, hereinafter "Shima'163").

Regarding claim 13, depending on claim 11, Shima does not disclose wherein, said printing apparatus registering means sorts the order in the list as to the information which identifies a printing apparatus determined as satisfying the predetermined condition, based on a predetermined order of priority, after the printing apparatus is registered into a list of communication available printing apparatus.

However, Shima'163 teaches in a printer system, that a list of printers (Fig. 11) can be sorted as to a predetermined condition. Paragraph 144 discloses that the list is sorted based on the distance to the printer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Shima, Lee and Suzuki to include the teachings of Shima'163. The motivation for this is to provide information that is more convenient for the user.

Regarding claim 14, depending on claim 13, Shima does not disclose wherein, said predetermined order of priority is a order given to each model.

Shima'163 teaches a printer list that includes printer models (Fig. 11). Shima'163 discloses sorting based on distance (Paragraph 144) but does not specifically state that it sorts based on the listed printer model.

It was well-known at the time of the invention to sort lists based on existing categories (Fig. 11 shows the printer model as an existing category). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Shima, Lee, Suzuki and Shima'163 to sort based on the printer model to provide more information in a convenient manner for the user.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Tzeng whose telephone number is (571) 270-7173. The examiner can normally be reached on Monday-Friday 7:30am-5pm EST with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Q. Tieu can be reached on (571) 272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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